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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,892	11/17/1999	John S. Hendricks	026880.00011	5151
4372	7590	11/02/2007	EXAMINER	
ARENT FOX LLP			SHAH, AMEE A	
1050 CONNECTICUT AVENUE, N.W.			ART UNIT	
SUITE 400			PAPER NUMBER	
WASHINGTON, DC 20036			3625	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/441,892	<b>Applicant(s)</b> HENDRICKS ET AL.	
	<b>Examiner</b> Amee A. Shah	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-19,22-33,42-74 and 89-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-19,22-33,42-74 and 89-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1, 3-19, 22-33, 42-74 and 89-97 are pending in this action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 18, 2007, has been entered.

#### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: Applicant claims priority to applications numbered 07/991074, 08/336247, 08/160194, 08/906469, and 09/191520 as a continuation in part. However, none of these provide support for

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the entirety of claim 1, including but not limited to, the aspects of claim 1 relating to negotiating prices. Therefore, the priority date for this application is the filing date of November 17, 1999.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p) they contain text that is almost illegible as being too small and will not reproduce properly.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There is no claim numbered 2; thus claims after claim 1 must be renumbered.

### ***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6, 14, 22, 25, 26, 31, 32, 46, 48, 51-54, 72 and 73 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4-6, 14, 22, 25, 26, 31, 32, 46, 48, 51-54, 72 and 73 depend on steps of claims 1, 4, 29, 45, 47, 50, and 70

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which contain steps or elements with the limitation "included." The phrase "included" excludes any element, step or ingredient not specified in the claim. A claim which depends from a claim which consists of "included" cannot add an element or step. (See MPEP §2111.02.) Thus, claims 4-6, 14, 22, 25, 26, 31, 32, 46, 48, 51-54, 72 and 73 are rejected because they attempt to further narrow claims which cannot be further narrowed.

#### ***Examiner Note***

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

**Claims 1, 3-19, 22-24, 27-29, 33, 42-65, 68-70, 74 and 88-97 rejected under 35 U.S.C. §103(a) as being unpatentable over Hoffman et al., US 2005/0144133 A1 (hereafter referred to as "Hoffman") in view of Aggarwal et al., US 6,885,000 B1 (hereafter referred to as "Aggarwal").**

Referring to claim 1. Hoffman teaches a method for providing electronic commerce using an electronic book comprising displaying an electronic book and presenting associated with the electronic book an identification of a product or service so that the user can purchase the selected product or service (e.g. ¶¶0190-0192 and 200 – note that the user read his/her electronic books and that the system can insert graphic images relating to products using the user's history).

Aggarwal teaches a method for providing electronic commerce comprising displaying a product (col. 5, lines 39-47 - note the product is "item A"); presenting identification of a product or service associated with item A (col. 5, lines 47-51, and col. 6, lines 1-8 – note the associated product or service can be "item A and B," "item B" or "item C"); receiving a user's selection of the product or service and a request to purchase the selected product or service (col. 5, lines 45-47 and col. 6, lines 8-9); and performing a transaction to execute the purchase request, wherein the performing step includes: receiving from the user an offered price for the product or service

(col. 6, lines 8-9); determining whether to accept the offered price (col. 6, lines 11-16); selectively transmitting an indication of an acceptance of the offered price based upon the determining (col. 6, lines 13-15 and 19-21); and receiving from the user one or more new offered prices if the offered price is not acceptable upon the determining (col. 6, lines 26-34), wherein the determining step includes determining whether to accept the offered price based upon at least one of the following criteria: an amount of the offered price, any available rebates relating to the selected product or service, any available discounts relating to the selected product or service, or a range of acceptable prices for the selected product or service (col. 6, lines 19-34 – note the determination is made based on the offered price and a range of acceptable price based on the user's profile).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of providing an electronic book with purchasable products or services, as taught by Hoffman, with the known elements of having those products be associated with other products and negotiating for the price of the products, as taught by Aggarwal, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal would yield the predictable results of better targeting the advertising of products for the user, thus increasing the probability of a sale.

Referring to claim 3. Hoffman and Aggarwal teach the method of claim 1, further including: receiving a request from the user for information concerning a particular product or service (Aggarwal, col. 5, line 60 through col. 6, line 8 - note the request is the viewing of details

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of an item or visiting the page); and displaying information concerning the particular product or service in response to the request (Aggarwal, col. 6, lines 5-11—note the displayed information is the request to quote a price). One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal would yield the predictable results of providing more detail to allow the customer to make a better choice, thus increasing the probability of a sale.

Referring to claims 4 and 5. Hoffman and Aggarwal teach the method of claim 1 but does not specifically teach wherein the performing step includes electronically obtaining payment for the product or service and a digital coupon (Aggarwal, col. 6, lines 44-55 - note the electronic payment is the use of a credit card in e-commerce and the coupon is the discount). One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal would yield the predictable results of obtaining payment, thus allowing the merchant to make a profit or recoup costs from the sale.

Referring to claims 6 and 7. Hoffman and Aggarwal teach the method of claim 1 wherein the performing step includes establishing an electronic communication with a web site for executing the purchase request (Hoffman, e.g. ¶¶0183-0185 – note that the user can access web sites, i.e. launching browsers, as part of the purchase request, thus establishing an electronic communication with a web site for executing the request).

Referring to claim 8. Hoffman and Aggarwal teach the method of claim 1 wherein the presenting step includes displaying an icon identifying the product or service, and the receiving



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step includes receiving selection of the icon by the user (Hoffman, ¶0207 and Aggarwal, col. 6, lines 5-18).

Referring to claims 9-13. Hoffman and Aggarwal teach the method of claim 1 wherein the presenting step includes selecting and displaying information, e.g. in the form of advertisements and multimedia, relating to the product or service (Hoffman, e.g. ¶¶0190 and 0207-0209 and Aggarwal, col. 6, lines 5-15). While Hoffman and Aggarwal both teach selecting and displaying information in the form of advertisements and multimedia, it is noted that the form of displaying information is non-functional descriptive material that does not functionally relate to the step of displaying - the information would be displayed in the same manner and for the same purpose regardless of whether the display was in the form of advertisements or multimedia. Thus, the form of display would not patentably distinguish the step of displaying from the prior art.

Referring to claim 14. Hoffman and Aggarwal teach the method of claim 1 wherein the presenting step includes displaying an identification of a digital product and the performing step includes downloading the digital product into a memory associated with the viewer (Hoffman, ¶¶0183-0185).

Referring to claims 15-18. Hoffman and Aggarwal teach the method of claim 1 further including recording statistical information relating to the purchase request and purchases (Hoffman, ¶0189 and Aggarwal, col. 5, lines 1-10).

Referring to claim 19. Hoffman and Aggarwal teach the method of claim 1 further including: receiving from the user a request for display of information concerning a particular product or service (Aggarwal, col. 5, line 60 through col. 6, line 8 - note the request is the viewing of details of an item or visiting the page); displaying information relating to the particular product or service in response to the request (Aggarwal, col. 6, lines 5-11—note the displayed information is the request to quote a price); and displaying information relating to products or services associated with the particular product or service (Aggarwal, col. 5, lines 50-55). One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal would yield the predictable results of providing more detail to allow the customer to make a better choice, thus increasing the probability of a sale.

Referring to claims 22 and 23. Hoffman and Aggarwal teach the method of claim 1 wherein the performing step includes encrypting the transaction with a digital signature for secure execution of the purchase request (Hoffman, e.g. ¶¶0100-0103).

Referring to claim 24. Hoffman and Aggarwal teach the method of claim 1 wherein: the displaying step includes displaying a hypertext link identifying the product or service; and the receiving step includes receiving selection of the hypertext link (Hoffman, ¶¶0198 and 0207-0209).

Referring to claims 27 and 28. Hoffman and Aggarwal teach the method of claim 1 further including providing a sample of the product using the viewer, e.g. a video clip, an audio clip, a portion of an electronic book, an image, a slide show, or an animation (Hoffman, ¶¶0198-0200 – note the samples are the graphic images associated with a product).

Referring to claims 29 and 33. Hoffman and Aggarwal teach the method of claim 1 further including generating and presenting a customized electronic catalog, including the identification of the product or service and an identification of other products or services, based upon information related to the user (Hoffman, ¶¶0198-0200 and Aggarwal, col. 5, line 45 through col. 6, line 17– note that the catalog is a listing of products).

Referring to claims 42-65, 68-70, 74 and 88-97. All of the limitations in apparatus and method claims 42-65, 68-70, 74 and 88-97 are parallel to the limitations of method claims 1-19, 22-24 and 27-29, discussed above, and are rejected on the same bases.

**Claims 25, 26, 66 and 67 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hoffman in view of Aggarwal and further in view of Williams et al., US 6,016,484 (hereafter referred to as “Williams”).**

Referring to claims 25 and 26. Hoffman and Aggarwal teach the method of claim 1 but not specifically wherein the performing step includes: presenting an electronic order form on the viewer based upon stored information identifying the user and payment information, and receiving a completed and submitted version of the electronic order form for the execution of the

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purchase request. In the same field of endeavor and/or pertaining to the same issue, Williams teaches a method and apparatuses for presenting an electronic order form on the viewer; based upon stored information identifying the user and payment information; and receiving a completed and submitted version of the electronic order form for the execution of the purchase request (Fig. 11 and col. 31, lines 28-48).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of displaying an electronic book with products r services associated with it and allowing for negotiating of prices, as taught by Hoffman and Aggarwal, with the known elements of presenting a order from based upon stored information and receiving a completed form to execute the purchase, as taught by Williams, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal with Williams would yield the predictable results of allowing the customer to know exactly what is being ordered and the amount being paid before submitting, i.e. confirming the order, leading to less customer duplications and higher customer satisfaction.

Referring to claims 66 and 67 – All of the limitations in apparatus claims 66 and 67 are parallel to the limitations of method claims 25 and 26, discussed above, and are rejected on the same bases.

**Claims 30-32 and 71-73 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hoffman in view of Aggarwal and further in view of Yamauchi et al., US 5,613,109 (hereafter referred to as “Yamauchi”).**

Referring to claims 30 -32. Hoffman and Aggarwal teach the method of claim 1 wherein the displaying step includes displaying an electronic catalog, as discussed above, but does not specifically teach displaying an interactive electronic catalog within the electronic book as an insert or overlaid image. Yamauchi, in the same field of endeavor and/or pertaining to the same issue, teaches a method and apparatus for inserting advertising within electronic books, such advertising comprising electronic catalogs (see, e.g., Abstract and col. 5, lines 22-42 and col. 19, lines 12-19).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of displaying an electronic book with products or services associated with it and allowing for negotiating of prices, as taught by Hoffman and Aggarwal, with the known elements of displaying the products as inserted or overlaying images, as taught by Yamauchi, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Hoffman and Aggarwal with Yamauchi would yield the predictable results of increasing the advertising benefits to advertiser of more targeted advertising, better placement and display, thus increasing the possibility of a sale.

Referring to claims 71-73 – All of the limitations in apparatus claims 71-73 are parallel to the limitations of method claims 30-32, discussed above, and are rejected on the same bases.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 38-42, 89, 93 and 97 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

  
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PRIMARY EXAMINER  
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